

<p align="center">PRE-APPEAL BRIEF REQUEST FOR REVIEW</p> <p align="center">(filed with the Notice of Appeal)</p>		Docket Number: 049213 / 289068
Application Number: 10/675,405	Filed: September 30, 2003	
First Named Inventor: Thomas W. Trueb		
Art Unit: 3677	Examiner: Saether, Flemming	
<p>Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p align="right">Respectfully submitted,</p> <p align="right">/R. Flynt Streat/</p> <p align="right">R. Flynt Streat Registration No. 56,450</p> <p>Date <u>April 6, 2007</u></p> <p>Customer No. 00826 ALSTON & BIRD LLP Bank of America Plaza 101 South Tryon Street, Suite 4000 Charlotte, NC 28280-4000 Tel Charlotte Office (704) 444-1000 Fax Charlotte Office (704) 444-1111</p> <p>ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON APRIL 6, 2007.</p>		

Attachment
Reasons for Requesting Pre-Appeal Brief Request For Review

Applicants are requesting a Pre-Appeal Brief Request For Review on the basis that the Examiner has failed to satisfy all elements required for a *prima facie* rejection and, more specifically, the Examiner has failed to show proper motivation for making a modification in an obviousness rejection under 35 U.S.C. §103(a).

A. Final Office Action

The present application includes three sets of claims: Claims 1-10 are directed to a fastener for securing adjacent portions of a cover member; Claims 11-18 and 19-20 are directed to a cover assembly comprising the foregoing fastener and a cover member. Claims 11-20 were withdrawn in response to a previous restriction requirement.

Claims 1-10 stand rejected under a Final Office Action dated December 6, 2006. Specifically, Claims 1-4 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 3,717,067 to Vick (“the Vick ‘067 patent”) in view of U.S. Patent No. 2,172,553 to Tripp (“the Tripp ‘553 patent”) and U.S. Patent No. 4,718,802 to Rockenfeller (“the Rockenfeller ‘802 patent”). Dependent Claims 5-7, 9 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Vick ‘067 patent in view of the Tripp ‘553 patent and the Rockenfeller ‘802 patent, and further in view of U.S. Patent No. 5,842,319 to Ravetto. Dependent Claims 5-8 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Vick ‘067 patent in view of the Tripp ‘553 patent and the Rockenfeller ‘802 patent, and further in view of U.S. Patent No. 2,328,823 to MacKenzie.

Applicants respectfully submit that the Examiner has not established a *prima facie* case of obviousness with regard to the invention as recited in independent Claim 1, as there is no suggestion or motivation to combine the references as proposed in the Office Action. Accordingly, for the reasons discussed below, Applicants request that the rejections directed to Claims 1-10 be withdrawn.

B. Invention

The invention of the present application provides a rigid fastener for securing together adjacent portions of a cover member made of a resiliently deformable material. The fastener is capable of being inserted into the cover member to its full depth for semi-permanent engagement, or may be partially inserted into the cover member to effect temporary interengagement sufficient to avoid inadvertent disengagement thereof while the cover member is appropriately positioned. As a result, when partially inserted, the fastener is capable of being disengaged from temporary interengagement using a gentle pulling force.

Claim 1 of present application is the only independent claim. Claims 2-10 depend from Claim 1, and thus incorporate all of the claim recitations of independent Claim 1. Claim 1 recites the following:

A rigid fastener for securing to one another adjacent portions of a cover member made of resiliently yieldable material, said fastener being of generally cylindrical form and having opposite end portions, at least one of said end portions being a double-effect engagement portion comprised of an axially outward end section, having a first inside diameter and a first effective outside diameter, and an axially adjacent inward section having a second inside diameter and a second effective outside diameter, wherein said second effective outside diameter is substantially larger than said first effective outside diameter, each of said sections of said engagement portion being comprised of a plurality of circumferentially extending, mutually adjacent retaining elements engageable in mating recess sections formed into a portion of a resiliently yieldable cover member, said retaining elements of said outward end section of said engagement portion being of said first effective outside diameter and said retaining elements of said inward section being of said second effective outside diameter, wherein said first inside diameter and said second inside diameter are substantially the same, and wherein crests of at least some of said retaining elements of said outward section are rounded for easy disengagement of said outward section from the cover member.

C. Prior Art

The Vick '067 patent, which the Examiner relies on as the primary reference, discloses a nail-like device for securing an underlayment layer to a subflooring layer when installing flooring. The nail-like device includes an upper section **12** and a lower section **13**. The upper and lower sections each have annular grooving, but the diameter of the upper section **12** is larger than the diameter of the lower section **13**. (See Col. 4, ll. 28-34; Fig.1). As disclosed in the Vick '067 patent, the principal improvement is the "combination of three features which cooperate to

prevent nail popping [and] dimpling.” (See Col. 2, ll. 31-34). These three features are “a completely embeddable head, annular grooving, and a differential diameter shank.” (See Col. 2, ll. 35-36).

The Tripp ‘553 patent discloses a nail device for driving into wood. (See Col. 1, ll. 1-11). The nail device includes a portion having projections **9** with sharper rings **11**, and another section with larger diameter rings **13**. (See Col. 2, ll. 21-26; Fig. 2). The Office Action asserts that the inner diameter of both sections of the device of the Tripp ‘553 patent appear to be the same diameter. (See Final Office Action, page 3).

The Rockenfeller ‘802 patent discloses a rigid nail **1** having a sawtooth profile section **4**. The teeth in the sawtooth profile include ridges **5** and inclined flanks **6**. The crests **5a** of the ridges are rounded. (See Col. 4, ll. 64-66; Fig. 6).

Since Claims 1-10 include a single independent claim, namely, independent Claim 1, Applicants will focus this pre-appeal brief on the rejection in the Final Office Action directed to independent Claim 1, *i.e.*, the rejection of Claim 1 under 35 U.S.C. §103(a) as being unpatentable over the Vick ‘067 patent in view of the Tripp ‘553 patent and the Rockenfeller ‘802 patent. Applicants submit that the patentability of dependent Claims 2-10 rise or fall on the patentability of independent Claim 1.

D. Legal Precedent

The basic requirements of a *prima facie* case of obviousness are: (1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings; (2) a reasonable expectation of success; and (3) when combined, the prior art references, teach or suggest all the claim limitations. See MPEP § 2142.

When considering whether there is some suggestion or motivation to modify a reference or combine reference teachings, the Examiner must consider the teachings of each reference in their entirety, including those teachings which may negate the proposed modification or combination. See *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004); MPEP § 2413.01. In this regard, if the proposed modification of a prior art reference would render the prior art invention being modified unsatisfactory for its intended purpose, there is no suggestion or motivation to make the proposed modification. See MPEP § 2413.01; *In re Gordon*, 733 F.2d

900, 902 (Fed. Cir. 1984) (finding error in the Board of Appeals' affirmation of an examiner's obviousness rejection reasoning that if the prior art reference were to be modified, as proposed by the examiner, the prior art reference would be rendered inoperable for its intended purpose). Similarly, if the proposed modification of the prior art reference would change the principle operation of the prior art invention being modified, the teachings of the references are not sufficient to render the claims *prima facie* obvious. See MPEP § 2413.01; *In re Ratti*, 270 F.2d 810, 813 (Fed. Cir. 1984) (reversing the Board of Appeals' affirmation of an examiner's obviousness rejection finding that the modification of the primary reference was not a proper ground for rejection because the proposed modification would change the basic principle under which the primary reference operated).

E. Application of Legal Precedent to Final Rejection of Independent Claim 1

In the Final Office Action, the Examiner modifies the Vick '067 patent with the Rockenfeller '802 patent, stating that "Vick also does not disclosed [sic] the at least some of the retaining elements having rounded crests. Rockenfeller discloses a similar fastener and shows the crests of the barbs to be rounded (see Fig. 6)." See Final Office Action, page 3.

The Vick '067 patent discloses the principal improvement is the "combination of three features which cooperate to prevent nail popping [and] dimpling." (See Col. 2, ll. 31-34). These three features are "a completely embeddable head, annular grooving, and a differential diameter shank." (See Col. 2, ll. 35-36). As taught by the Vick '067 patent, conventional nails are subject to popping in a variety of ways, including where "[t]he nail, may be withdrawn by swelling underlayment which exerts an upward pressure on the shaft and the underside of the nail head," and where "[a] downward force [is] applied to the underlayment ... that exceeds the withdrawal resistance of the nail in the underlayment." (See Col. 1, ll. 46-48 and Col. 1, ll. 56-62). Figure 1 of the Vick '067 patent illustrates that the edges of the crowns **15**, **17** create a sharp point. The Vick '067 patent further discloses that the crowns and annular grooves cause the device to have greater resistance to slippage. (See Col 4., ll. 35-37). This structure allows the device of the Vick '067 patent to resist nail popping and dimpling.

1. Proposed combination would render Vick unsatisfactory for its intended purpose.

The rounded crests recited in independent Claim 1 aid in the ability of the fastener of the present invention to be disengaged from temporary interengagement with the cover member using a gentle pulling force. More specifically, the rounded crests reduce the resistance to disengagement. The Examiner's proposed modification of the Vick '067 patent to include the rounded corners of the Rockenfeller '802 patent would cause Vick to be unsatisfactory for its intended purpose of preventing nail popping and dimpling, since the combination would decrease the resistance of Vick to slippage and, thus, facilitate nail popping. Thus, there is no suggestion or motivation to make the proposed combination as Vick teaches away from the proposed modification. *See* MPEP § 2413.01; *In re Gordon*, 733 F.2d 900, 902 (Fed. Cir. 1984).

2. Proposed combination would change the principle of operation of Vick.

Figure 1 of the Vick '067 patent illustrates that the edges of the crowns **15, 17** create a relatively sharp point. The Vick '067 patent further discloses that the crowns and annular grooves cause the device to have greater resistance to slippage. (*See* Col 4., ll. 35-37). This structure allows the device of the Vick '067 patent to resist nail popping and dimpling. The Examiner's proposed modification of the Vick '067 patent to incorporate the rounded crests of the Rockenfeller '802 patent changes the basic principles under which the Vick construction was designed to operate, since the rounded crests decrease the resistance to slippage. Thus, there is no suggestion or motivation to make the proposed combination. *See* MPEP § 2413.01; *In re Ratti*, 270 F.2d 810, 813 (Fed. Cir. 1984). Indeed, when viewed at the time the present invention was made, and without the benefit of Applicants' disclosure, there is nothing in Vick or Rockenfeller which suggests Applicants fastener as recited in independent Claim 1.

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Given that all of the claim rejections of the Final Office Action require modifying the Vick '067 patent to incorporate the rounded crests of the Rockenfeller '802 patent, the Examiner has not established a *prima facie* case of obviousness with respect to independent Claim 1, or any of the claims depending therefrom. Accordingly, Applicants respectfully submit that the rejections of Claims 1-10 should be reversed.